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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,508	05/29/2001	David Boreham	P5833	7420

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WAGNER, MURABITO & HAO LLP
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EXAMINER

LU, KUEN S

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 03/24/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,508

Applicant(s)

BOREHAM ET AL.

Examiner

Kuen S Lu

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings filed on 5/29/2001 are not approved by the Draftsperson under 37 CFR 1.84 or 1.152, formal drawings are required in response to this office action, Figures 1-24.

The drawings are objected to as failing to comply with 37 CFR 1.84(p) because Figure legends are poor. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is mostly connected, to make and/or use the invention.

Claim 1 recites only a single step, a method comprising of a single step for grouping entries in a directory server for assigning an entry to an enumerated role. This single and only method of the claim, seems to encompass all possible manners for restricting access to private information, as set forth in the preamble [MPEP 706.03(c)]. Ex Parte Bullock, 1907 C.D.93;127 O.G.1580.2164.08(a).

>A single step claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re

Art Unit: 2177

Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Although the court in *Fiers v. Sugano*, 984 F.2d 164, 25 USPQ2d 1601 (Fed. Cir. 1993) did not decide the enablement issue, it did suggest that a claim directed to all DNAs that code for a specified polypeptide is analogous to a single means claim.<

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

Claim 1 sets forth a method of grouping entries in a directory server. The body of the claim, however, merely recites the single step of assigning an entry to an enumerated role. The claim fails to recite a series of steps that logically amount to the method of grouping entries.

Claims 2-5 are rejected due to their dependency on Claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-10 are rejected under 35 U.S.C. 102(a) as anticipated by iPlanet Directory Server Administrator's Guide (Version 5.0, April 2001, Sun Microsystems, Inc., hereafter iPlanet).

As per claims 1 and 6, iPlanet teaches the following:

"grouping entries in a directory server, said directory server configured to contain roles" at Pages 158-160, sections "Creating a Managed Role", "Creating a Filtered Role" and "Creating a Nested Role" by adding role as an attribute at step 3 or 4; and "assigning an entry to an enumerated role, whereby the entry can be selected by selecting all entries that possess the enumerated role" at Page 156, last article of the Para. "About Roles" by assigning a particular role to a given entry; and "selecting all entries that possess the enumerated role" at Page 161, Section "Modifying a Role Entry", steps 1 through 6 by editing entries of an existing role and changing members of managed and nested roles or filter of a filtered role.

As per claims 2 and 7, iPlanet teaches the following:

"enumerated role is possessed by an arbitrary number of entries" at Page 156, the first article of the Section "About Roles" by enumerating the members of a role and at Pages 43-44, Section "Adding an attribute to an entry" by assigning a role to multiple entries.

As per claims 3 and 8, "if an entry that possesses the enumerated role is a nested role, then rejecting that entry without further processing of the entry" at Page 166, Para. "Nested roles" by considering nested role is comprised of filtered and managed roles and, thus an entry possesses a role enumerated to be nested will reject for further processing of the entry.

As per claims 4 and 9, iPlanet teaches "providing a set of expressions and boolean operations for use to match entries in a directory search" at Page 496, Section "Using

Compound Search Filters" by combining or nesting Boolean operators to form a complex expression.

As per claims 5 and 10, iPlanet teaches "the expressions comprise any one or more of operands connected by the operators, equal = where an instance of the attribute exactly matches the value; contains * which is used as a wild card to allow presence check or partial matches; sounds like = which is used in name searches; greater or equal >= which is used for numerical comparisons; less or equal <= which is used for numerical comparisons; negation ! which is used to negate any expression; and & which is used to combine two expressions; and or | which is used to select from two expressions" at Pages 494-496.

The prior art made of record

4. A. iPlanet Directory Server Administrator's Guide, Version 5.0,
Sun Microsystems, Inc. Doc. ID 816-0799-01, April, 2001.

Response to Arguments

5. Applicants have submitted, February 2, 2004, a declaration under 37 C.F.R. 1.132 attempting to show that the iPlanet publication is applicants' invention.

The Examiner notes that the only statement addressing the issue is in paragraph number 3, which states "We conceived and invented the subject matter disclosed the above iPlanet reference".

This statement is inadequate to remove the reference as prior art. Applicants must (a) show, by way of evidence, that he or she made the invention upon which the relevant disclosure is based and (b) that the author of the publication derived his knowledge of

Art Unit: 2177

the relevant subject matter from Applicant. (See MPEP 715.01(c), subsection entitled "DERIVATION")

No evidence is provided to support declarant's conclusory statement. Furthermore, declarant's statement can be read to merely mean that the iPlanet publication discloses what Applicants have independently invented. As the issue is not whether Applicants have independently invented but whether the reference is attributable to Applicants, the declaration is not effective.

6. In light of the forgoing arguments, the U.S.C 102 rejection for Claims 1-10 is hereby sustained.

Conclusions

7. THIS ACTION IS MADE FINAL.

The Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2177

8. The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is (703) 305-9601 for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S Lu whose telephone number is 703-305-4894. The examiner can normally be reached on 8 AM to 5 PM, Monday through Friday.

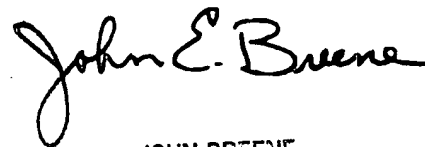
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Kuen S. Lu 

Patent Examiner

March 10, 2004



JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100